

REMARKS

Applicant appreciates the thorough examination of the present application as evidenced by the Official Action of June 29, 2005 (hereinafter "Office Action") and the Final Official Action of November 14, 2005 (hereinafter "Final Action"). However, Applicant respectfully maintains that pending Claims 33, 35, and 37 are patentable over the cited references. In particular, Applicant respectfully submits that the cited references do not disclose or suggest, at least, receiving an identifier of a first advertisement and an identifier of a second advertisement (in lieu of the advertisements themselves) from the advertiser.

Accordingly, Applicant submits that pending Claims 33, 35, and 37 are in condition for allowance. Favorable reconsideration of these claims is respectfully requested for at least the reasons discussed hereafter. In the interest of brevity, Applicant's remarks below will focus on the "Response to Arguments" section on page 7 of the Final Action. To ensure that Applicant's remarks are fully responsive to the Final Action, Applicant's previous Amendment mailed September 6, 2005 is hereby incorporated by reference herein.

Claims 33, 35, and 37 Are Patentable Over the Cited References

Claims 33, 35, and 37 stand rejected under 35 USC §103 as being unpatentable over U.S. Patent No. 5,740,549 to Reilly et al. ("Reilly") in view of U.S. Patent No. 6,324,519 to Eldering ("Eldering"). Claim 33 recites:

33. A method for subscriber based generation of a customized publication comprising the steps of:

generating a subscriber list including identifications of a plurality of subscribers for the publication;

providing, to an advertiser, at least a portion of the subscriber list including identifications of a first of the subscribers and a second of the subscribers different from the first subscriber;

receiving an identifier of a first advertisement based on buying preferences of the first subscriber and an identifier of a second advertisement based on buying preferences of the second subscriber from the advertiser;

associating the first advertisement with the first subscriber based on the identification of the first subscriber;

associating the second advertisement, different from the first advertisement, with the second subscriber based on the identification of the second subscriber; and

then

generating a first version of the publication including the first advertisement in a prescribed field of the publication for the first subscriber;

generating a second version of the publication including the second advertisement in a prescribed field of the publication for the second subscriber; integrating content not designated by the advertiser into the first version of the publication and the second version of the publication;

printing the first version and the second version of the publication; and

distributing the printed first version of the publication to the first subscriber and the printed second version of the publication to the second subscriber.

(Emphasis added).

Accordingly, some embodiments of the present invention provide that an *identifier* of an advertisement (in contrast to the advertisement itself) is received from the advertiser. The actual advertisement may be maintained, for example, by a publisher, rather than by an advertiser.

In the "Response to Arguments" section, the Final Action asserts that Reilly discloses "an indication of each advertisement that a user has interacted with such as *clicking on the advertisement* to connect to the advertiser's World Wide Web page (col 6, lines 1-10). This implies that said advertisement has a name to be recognized, where the name is an identifier of the advertisement." *See* Final Action, Page 8. As such, the Final Action appears to assert that clicking on the name of the advertisement corresponds to "receiving an identifier" of an advertisement, as recited by Claim 33. However, Applicant maintains that nowhere does Reilly appear to disclose or suggest receiving the name/identifier of the advertisement **from an advertiser**. Rather, as provided by the cited portion of Reilly:

Finally, the information database 134 includes advertising display statistics 148 and news item display statistics 149. The display statistics are collected from the subscribers' computers when the subscribers' computers call in for updated news stories and the like. Advertising display statistics indicate how many times each advertisement has been displayed on subscribers' computers. In a preferred embodiment, display statistics for each advertisement are divided into a display count for displaying during data viewer usage, a display count for other display instances, and an indication of each advertisement the user has interacted with, such as by "clicking" on the advertisement to connect to the advertiser's World Wide Web page. News item display statistics 149

concern how much time the subscriber spent viewing each non-advertising item in the data viewer as well as the amount of time the screen saver was active for each information category. (*Emphasis added*).
See Reilly, Col. 6, lines 1-10.

In other words, Reilly provides that the indication of each advertisement with which the user has interacted is a display statistic collected (*i.e.* received) **from the subscriber's computers**. As such, the indication of the advertisement is not received "from the advertiser", as recited by Claim 33. Actually, Reilly does not even appear to contain any mention of an advertiser, and rather, describes an information and advertising distribution system including an information server and a client computer/workstation. See Reilly, Fig. 12. Moreover, even were the information server of Reilly construed as an advertiser, nowhere does Reilly appear to disclose or suggest receiving an identifier of an advertisement, in lieu of the advertisement content itself, from the server. Accordingly, Applicant submits that Reilly does not appear to disclose or suggest all of the recitations of Claim 33.

Nor does Eldering appear to provide such recitations. Eldering describes a system where advertisers can bid to have their printed material included in a publication that is delivered to multiple subscribers. As shown in Fig. 7 of Eldering, an advertisement 750 (rather than an identifier thereof) is transmitted from the advertiser 144 and received at the content/opportunity provider 160. See Eldering, Fig. 7. Thus, Eldering also does not appear to disclose or suggest "receiving an identifier of a first advertisement...and an identifier of a second advertisement...from the advertiser", as recited by Claim 33.

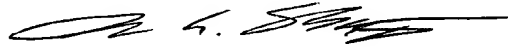
Accordingly, neither Reilly nor Eldering disclose or suggest "receiving an identifier of a first advertisement...and an identifier of a second advertisement...from the advertiser", as recited by Claim 33. As such, Applicant submits that Claim 33 is patentable over the combination of Reilly and Eldering for at least the reasons described above. Claims 35 and 37 are system and computer program product analogs of Claim 33, and include recitations corresponding to those discussed with reference to Claim 33. As such, Claims 35 and 37 are patentable for at least substantially the same reasons.

In re: Mark E. Peters
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Conclusion

In view of the arguments presented above, Applicant respectfully submits that Claims 33, 35, and 37 are patentable over the cited references. Accordingly, Applicant respectfully requests reconsideration of the outstanding rejections and allowance of Claims 33, 35, and 37, and passing this application to issue.

Respectfully submitted,

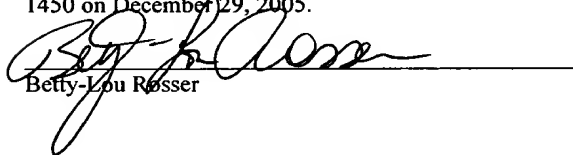


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